

REMARKS

The Office Action mailed April 15, 2009 has been received and reviewed. Claims 1 through 30 and 32 are noted therein as currently pending in the application. Claim 31 was earlier canceled. Claims 1, 12, 27 and 32 are amended and claim 26 is canceled. Reconsideration of the application as amended herein is respectfully requested.

Withdrawal of Rejections

The withdrawal of the claim rejections under 35 U.S.C. § 102(e) over U.S. Patent Application Publication 2003/0034525 to French et al. is noted with appreciation.

35 U.S.C. § 103(a) Obviousness Rejections

Claims 1 through 6, 10 through 19, 28 through 30, and 32 were rejected in the Office Action as assertedly being obvious under 35 U.S.C. § 103(a) over US Patent 5,405,656 ("Ishikawa") in view of U.S. Patent 5,731,364 ("Sinta"). Independent claims 1, 12 and 32 have all been amended herein, and it is respectfully submitted such claims define over the combination of references suggested in the Office Action.

Each of independent claims 1, 12, and 32 have been amended to include subject matter from canceled claim 26, and now require that the process include the step of "after formation of the metal layer, removing the masking layer." It is noted that at page 7, the Office Action states that "Ishikawa in view of Sinta does not disclose that the masking layer (resist pattern) is removed after forming the metal layer". Accordingly, this rejection should be withdrawn.

It is acknowledged that claim 26 was rejected in the Office Action as assertedly being obvious under 35 U.S.C. § 103(a) over Ishikawa in view of Sinta, and further in view of U.S. Patent 5,981,135 ("Koes"), which states that "it would be obvious to a skilled artisan to modify Ishikawa in view of Sinta by employing a stripping process after the plating process as suggested by Koes, because Koes, in col 11, lines 19022 discloses that performing the stripping in the alkaline solvent reveals the desired pattern of copper traces or plated features." (Office Action at pages 7-8). Applicant respectfully submits

that examination of Ishikawa makes it clear that the present claim are not obvious.

A prior art reference relied upon for making the prima facie case of obviousness must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert denied, 469 US 851 (1984).

Beginning at column 2, line 61, Ishikawa sets forth one manner in which the invention thereof differs from the prior art, stating:

Under such circumstances, there have been proposed a variety of methods of partially applying a catalyst to the surface of a substrate, to thus permit a selective formation of Pt electrodes. For example, KOKAI No. 61-234351 proposes the use of an adhesive tape. More specifically, the method disclosed in this patent comprises masking, with an adhesive tape, portions of the surface of a substrate other than those on which Pt electrodes are to be formed, applying a catalyst under such a masking condition in a conventional manner, and then peeling off or removing the adhesive tape. **In this method, however, the adhesive tape for masking must be applied to each article and although this reduces the cost of the electrode material (such as Pt), the number of steps is increased.** (emphasis added).

Ishikawa thus teaches against masking "portions of the surface of a substrate other than those on which Pt electrodes are to be formed, applying a catalyst under such a masking condition in a conventional manner" which requires removing the mask in a manner that increases the number of steps needed to form the electrodes.

Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Modifying the Ishikawa methods to require removing a mask in a manner that increases the number of steps needed to form the electrodes would make these Ishikawa methods unsatisfactory for their intended purpose by increasing the time and expense of these methods. Thus, consideration of Ishikawa in its entirety leads away from the claimed invention.

For these reasons, it is respectfully requested that independent claims 1, 12 and

32 be allowed, together with dependent claims 2 through 6, 10, 11, 13 through 19, and 28 through 30.

Claims 7 through 9 and 20 were rejected in the Office Action as assertedly being obvious under 35 U.S.C. § 103(a) over Ishikawa in view of Sinta, and further in view of European Patent Application 0518422 ("De Bakker"). Such claims depend from independent claim 1 and are allowable as depending from an allowable base claim.

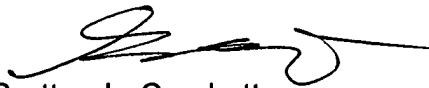
Claims 21 through 25 were rejected in the Office Action as assertedly being obvious under 35 U.S.C. § 103(a) over Ishikawa in view of Sinta, and further in view of De Bakker and U.S. Patent 5,395,678 ("Matsushima"). Such claims depend from independent claim 1 and are allowable as depending from an allowable base claim.

Claims 26 and 27 were rejected in the Office Action as assertedly being obvious under 35 U.S.C. § 103(a) over Ishikawa in view of Sinta, and further in view of Koes. Claim 26 has been canceled, rendering this rejection moot as to it, and the incorporation of subject matter from this claim into the independent claims has been addressed previously herein. With respect to claim 27, such claim depends from independent claim 1 and is allowable as depending from an allowable base claim.

CONCLUSION

All pending claims are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Office determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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